

## REMARKS

Claims 1-33 are currently pending in the application. Claim 14 is herewith amended to incorporate the limitations of claim 15. Accordingly, claim 15 is canceled. Claim 16 is amended to correct its dependency from claim 14. No new matter has been added. Reconsideration of the claims is respectfully requested.

The Applicants thank the Examiner for favorable consideration and allowance of claims 18-33.

In paragraph 1 on page 2 of the Office Action, claims 1-14 and 17 are rejected under 35 U.S.C. §102 (e) as being anticipated by Eberlin (U.S. Patent No. 5,702,048). The Applicants respectfully traverse the rejection.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102.

Applicants respectfully submit that Eberlin does not teach every element of independent claim 1 and therefore fails to anticipate claim 1.

The Applicants set forth in claim 1, a heart valve leaflet fastener comprising at least one pair of arms. The at least one pair of arms is sized and adapted for fastening

two adjacent heart valve leaflets. The arms pivot from one orientation to a gripping position with ends of respective paired arms being directed toward each other.

The Examiner cites Eberlin as reading on a surgical instrument comprising at least one pair of arms (3), wherein the arms (3) are sized and adapted for two adjacent leaflets; and wherein the arms (3) pivot from one orientation to a gripping position with ends of the pair arms being directed toward each other (Figs. 2, 3a and Figs. 13-15).

Eberlin does not anticipate the present invention. The arms disclosed by Eberlin, and referred to by the Examiner, are the fastener applicator arms for holding the staple 4. These are not the fastener arms (256, 258, 260, 262 in Fig. 13 and 302, 304, 306, 308 in Fig. 14) as claimed by the Applicants. This fundamental error is propagated throughout the claims rejections, rendering the use of Eberlin to anticipate the present invention improper.

The Eberlin staple applicator arms (3) are not sized and adapted for two adjacent heart valve leaflets. Instead, the Eberlin arms (3) referred to by Examiner simply hold a staple (4) and then crimp the same. In addition, the ends of the Eberlin staple applicator arms (3) do not pivot from one orientation to a gripping position and the ends are not directed toward each other, as is the heart valve leaflet fastener claimed by the Applicants. Instead, Eberlin's stapler applicator arms (3) pivot to a crimping position wherein the staple is simply crimped.

The Examiner compounds the error in his rejection regarding claims 4, 5 and 13 wherein he states that Eberlin Fig. 2 reads on a kit having a catheter (1), a fastener applicator (3) and a leaflet fastener (4). The catheter (1) has a suitable dimension for

deployment and insertion into a human heart. Furthermore, according to the Examiner, the pair of arms (3) comprise the gripping elements.

Again, the pair of arms (3) referred to by the Examiner as having “gripping elements” are, in Eberlin, the staple applicator arms, for holding the staple. The Examiner states that the fastener applicator comprises arms 3, but then tries to indicate that these arms 3 also comprise gripping elements. Contrary to the Examiner's assertions, the pair of arms claimed by the Applicants are the heart valve leaflet fastener arms, and are not the fastener applicator arms cited by the Examiner.

For at least the reasons set forth above, the Applicants respectfully submit that Eberlin fails to teach or suggest every feature set forth in Applicants' independent claims 1, 4 and 13. Because claims 1, 4 and 13 are not anticipated by Eberlin, claims 1, 4 and 13 are allowable over the cited reference. The Applicants respectfully request that the rejection of claims 1, 4 and 13 be withdrawn.

Dependent claims 2-3 and 5-12, which are dependent from independent claims 1 and 4, were also rejected under 35 U.S.C. §102(e) as being unpatentable over Eberlin. While Applicants do not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are moot in view of the remarks made in connection with independent claims 1 and 4. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent claims 2-12 are also in condition for allowance. The Applicants respectfully request the Examiner withdraw the rejection of claims 2-3 and 5-12.

The Applicants respectfully submit that Eberlin does not teach every element of independent claim 14 and therefore fails to anticipate claim 14.

The Applicants set forth in independent claim 14 a heart valve repair instrument comprising a ring and a ring applicator, wherein the ring is releasably attached to the applicator. The ring comprises two pointed shafts and the applicator can apply force to bring the two shaft points toward each other relative to an initial position. The ring and applicator are appropriately sized for placement within a chamber of a human heart.

Claim 14 has been rewritten to include the limitations of claim 15. Accordingly, claim 15 has been canceled. The Applicants respectfully request reconsideration of amended claim 14.

Original claim 16 now depends from amended claim 14 and has been amended to reflect this dependency. Accordingly, the Applicants respectfully submit that original claim 16 is in condition for allowance.

Original claim 17 depends from amended claim 14. In addition, the Examiner refers to a nonexistent notch in the crimped staple in Eberlin. This element is claimed, however, by the present invention. Accordingly, the Applicants respectfully submit that original claim 17 is in condition for allowance.

For at least the reasons set forth above, the Applicants respectfully submit that Eberlin fails to teach or suggest every feature set forth in Applicants' independent claim 14, as amended. Because amended claim 14 is not anticipated by Eberlin, claim 14 is allowable over the cited reference. The Applicants respectfully request that the rejection of claim 14 be withdrawn.

Dependent claims 16 and 17, which depend from independent claim 14, were also rejected under 35 U.S.C. §102(e) as being unpatentable over Eberlin. While Applicants do not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are moot in view of the remarks made in connection with independent claim 14. This dependent claims includes all of the limitations of the base claim and any intervening claims, and recites additional features which further distinguish claims 16 and 17 from the cited references. Therefore, dependent claims 16 and 17 are also in condition for allowance.

Applicants respectfully request withdrawal of the rejection of claims 1-14 and 17 under 35 U.S.C. §102 (e) as being anticipated by Eberlin.

In view of the reasons provided above, it is believed that all pending claims are in condition for allowance. Applicants respectfully request favorable reconsideration and early allowance of all pending claims.

#### **SUPPLEMENTARY COMMENTS REGARDING ADVISORY ACTION**

Applicants respectfully disagree with Examiner's comments in the Advisory Action in connection with the Eberlin reference, in particular as the Examiner relates Eberlin to pending claim 1. The Eberlin arms (3) are not used to fasten the tissues of sutured vessels as asserted by the Examiner. Instead, the arms (3) are simply used to hold a staple. It is the staple that fastens the tissue, not the arms 3. Thus, the Eberlin arms are sized and adapted for holding a staple, not for fastening two adjacent heart leaflets as claimed by Applicants. Moreover, the Eberlin arms do not pivot from one orientation to a

gripping position wherein the ends are directed toward one another as provided in pending claim 1. Applicants respectfully submit that Eberlin does not anticipate claim 1.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicants' attorney of record, Hallie A. Finucane at (952) 253-4134.

Respectfully submitted,

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